

REMARKS

The title of the application has been amended to recognize that all the claims currently in this application are directed to a method of preventing central nervous system disorders utilizing the bicyclic compounds of the present application.

All the claims submitted for examination in this application, Claims 1-6, have been rejected on formal grounds. Applicants have amended their claims and respectfully submit that all the claims currently in this application are patentable over the rejection of record.

The first formal ground of rejection is directed to all the claims currently in this application, Claims 1-6, which stand rejected, under 35 C.F.R. §1.112, first paragraph, for not being enabled by the specification. Specifically, the Official Action argues that although the specification enables claims directed to treating the diseases recited in Claim 1, the specification does not provide enablement for the present claims directed to preventing the diseases set forth in Claim 1.

That the specification is conceded in the outstanding Official Action to support claims directed to treatment of the recited diseases and conditions of Claim 1 is enough to be establish that the specification supports Claims 1-6, directed to a method of preventing these diseases utilizing the identical claimed compounds mentioned in claims employed in treating those diseases and conditions.

It is emphasized that at the outset that the applied authority, Ex parte Maas, 9 USPQ2d 1746 (Board of Patent Appeals and Interferences 1987), is unrelated to the issue of the patentability of the claims of the present application. In Maas the issue was whether in vitro experimental data, which provided the substantiating evidence

necessary to establish utility, is satisfactory where utility is sufficiently unusual. In the present application that issue does not arise. That is so insofar as the outstanding Official Action admits that the disclosure of the instant specification provides the requisite evidence that the claimed compounds have utility in treating the diseases recited in the claims of the present application. The only issue then is whether or not evidence establishing that a class of compounds effectively treat a class of diseases also evidences prevention of that class of diseases by that class of compounds.

That evidence of effective treatment of a disease by a class of compounds applies equally to the prevention of the disease has been established in In re Krimmel, 48 CCPA 1116, 1123, 292 F.2d 948, 953, 130 USPQ 215, 219 (CCPA 1961). Krimmel holds that prevention, alleviation or cure of some disease are substantially synonymous. That case held that prevention, alleviation or cure of some disease or manifestation of a disease are interchangeable evidence. That the decision held that any such evidence based on experiment animals doesn't necessarily apply to humans is irrelevant to the issue in this application, e.g., whether the evidence of treatment of disease applies to prevention of disease. In any event, the majority opinion on relevance to humans is set forth in In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (CCPA 1961) wherein it stated that tests on experimental animals are deemed sufficient to establish human utility.

The point is not whether the tests proffered is sufficient to enable the claims of the present application. This already has been conceded. The sole issue is whether a teaching sufficient to establish treatment of a disease with a class of compounds also establishes prevention of those diseases. That the terms are used interchangeable in the

case law merely confirms an intuitive conclusion, to wit, if a compound can treat a disease then it obviously can prevent that disease.

As such, the specification of the present application which provides enablement for the treatment of the recited diseases by the claimed compounds also provides enablement for preventing the identical diseases by the identical class of compounds. Reconsideration and removal of this ground of rejection is therefore deemed appropriate. Such action is respectfully urged.

The second formal ground of rejection is again directed to all the claims, Claim 1 to 6, currently in this application. Claims 1-6 stand rejected, under 35 C.F.R. §1.112, second paragraph, as being indefinite on two grounds.

The basis for the first of these grounds is the ambiguity associated with the phraseology “administering to a preventing effective amount of said mammal a compound of the formula” in Claim 1. This renders Claim 1 confusing and therefore that claim and Claims 2-6, which ultimately from Claim 1, are indefinite. The Official Action indicates that replacing the above quoted phrase with administering --to a mammal an effective amount of said compound of the formula-- would overcome this ground of rejection.

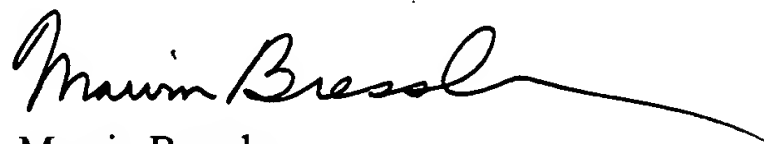
Applicants have amended Claim 1 in strict accordance with the suggestion made in the outstanding Official Action. As such, this obvious typographical error has been corrected and the indefiniteness of the first two grounds of rejection under 35 U.S.C. §112, second paragraph has been overcome.

The second ground of rejection based upon indefiniteness is predicated upon the recitation of Claim 6. Claim 6 stands rejected based on confused language therein. As in the first indefiniteness ground, Claim 6 includes an obvious typographical error. The redrafting of Claim 6 in exact accordance with the suggested language proposed in the outstanding Official Action overcomes this ground of rejection. That is, the suggested additional phrase--wherein the compound is--, disposed between "1" and "selected" in Claim 6 overcomes this ground of rejection.

It is respectfully urged that amendments to Claims 1 and 6, made after final rejection, be entered not only because the Official Action suggests such changes but, equally important, these amendments to Claims 1 and 6 clearly overcome the indefiniteness grounds of rejection.

The above amendment and remarks establish a patentable nature of all the claims currently in this application. Notice of Allowance and passage to issue of these claims, Claims 1-6, is therefore respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marvin Bressler", with a long horizontal flourish extending to the right.

Marvin Bressler
Registration No. 25,132
Attorney for Applicant

Scully, Scott, Murphy & Presser
400 Garden City Plaza-Ste. 300
Garden City, New York 11530
516-742-4343
MB:nf